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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,964	06/27/2001	Dwip N. Banerjee	AUS920010365US1	3819

7590 06/18/2004

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EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/892,964

Applicant(s)

BANERJEE ET AL.

Examiner

Md S Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Response to Argument*

1. The affidavit filed on March 19, 2004 under 37 CFR 1.131 has been considered but is ineffective to overcome the McCormack et al. reference, because the 2<sup>nd</sup> paragraph "Prior to march....." is just a statement without facts to support such statement.

2. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the McCormack et al. reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

The complete claimed invention was not conceived prior to the date of the McCormack reference. Exhibit A or B fails to support all the limitations of claims 1-25. There is no support for example, of having the display screen of the cell phone for displaying the content being downloaded while maintaining the voice call with the user in a digital wireless telecommunications network, wherein the content is a web page from a web server on the internet. Further, No evidence can be found that supports that Exhibit A or B exist before the filing date of McCormack et al. reference.

3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the McCormack et al. reference to either a constructive reduction to practice or an actual reduction to practice.

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For example, from Exhibit A to Exhibit J, there is insufficient diligence since the Examiner cannot determine the date of Exhibit A and Exhibit B.

Further, No evidence to show diligence between 03/22/2001 to 04/11/2001.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-15, 21, 22, 24 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by McCormack et al. (U.S. Pub. No. 2002/0136384).

Regarding claims 1 and 10, McCormack teaches receiving a voice call from a mobile caller (i.e., user of a cell phone) (abstract; fig.2; page 4, paragraph 0070).

McCormack further teaches conducting a voice conversation with the mobile caller (i.e., user of a cell phone) (abstract; fig.2; page 4, paragraph 0070).

McCormack further teaches while maintaining the voice call with the mobile caller (i.e., user of a cell phone), downloading content to the mobile handset (i.e., cell phone) for browsing on a browser (i.e., display on a display screen) of the mobile handset (abstract; fig.2; page 4, paragraphs 0070, 0072, 0073).

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Regarding claims 2 and 11, McCormack teaches the content is a web page from a web server on the Internet (abstract; fig.2; page 4, paragraphs 0073, 0074).

Regarding claims 3, 12 and 24, McCormack teaches placing the voice call in an on hold status, wherein the downloading step is performed while the voice call is in the on hold status (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claim 4, McCormack teaches the web page is downloaded to the cell phone from the web server after being converted into a wireless application protocol format by inherently a gateway coupling the Internet to the digital wireless telecommunications network (fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claim 5, McCormack teaches the html of the web page is inherently converted into wireless markup language by the gateway (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claims 6 and 13, McCormack teaches after the voice call is placed in an on hold status, a voice message is played to the user via the cell phone requesting the user to select the download of the content (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claims 7 and 14, McCormack teaches using inherently caller ID pertaining to the cell phone to select a particular content to download to the cell phone (fig.2; page 4, paragraphs 0070, 0072-0074).

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Regarding claim 8, McCormack teaches that the voice call and the download of the content are performed in parallel over a connection between the cell phone and the network using a packet switched protocol (abstract; fig.2; page 4, paragraphs 0070, 0072-0074).

Regarding claims 9 and 15, McCormack teaches discontinuing the downloading of the content when the on hold status is discontinued (page 4, paragraph 0073).

Regarding claim 21 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, McCormack teaches a wireless (i.e., digital wireless) network (fig.2).

McCormack teaches a router (i.e., switch) (fig.2).

McCormack further teaches a public switched telephone network coupled to the switch and to the digital wireless network (fig.2; page 2, paragraph 0044).

McCormack further teaches a telephone device coupled to the switch (fig.2).

Regarding claim 22 is rejected for the same reasons as discussed above with respect to claim 1.

Regarding claim 25, McCormack teaches that the mobile caller (i.e., web enabled telephone) browsing (i.e., displaying) the content simultaneously with the voice connection (page 4, paragraphs 0070, 0072, 0073).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 16-20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormack et al. (U.S. Pub. No. 2002/0136384) and in view of Tobita et al. (U.S. Pub. No. 2002/0009987).

Regarding claim 16, McCormack teaches browsing (i.e., displaying) a web page on a web enabled phone (fig.2; page 4, paragraphs 0073, 0074).

McCormack further teaches a router (i.e., switch) for coupling to a local area network (i.e., telecommunications network) and for connecting an extension to a mobile phone (i.e., cell phone) over the local area network (fig.2; page 4, paragraph 0070).

McCormack further teaches an application server for downloading the web page to the web enabled phone in parallel with a voice conversation occurring between the extension and the mobile phone (i.e., cell phone) (fig.2; page 4, paragraphs 0070, 0072, 0073).

McCormack fails to teach "a database storing html code". Tobita teaches a database storing html code (fig.12; page 8, paragraphs 0117, 0118). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormack to allow a database storing html code as taught by Tobita. The motivation for the modification is to have doing so in order to provide the user with a link to the HTML mail storage.

Regarding claim 17, McCormack teaches that the web page can be displayed on a display screen of the web enabled phone (fig.2; page 4, paragraphs 0070, 0072, 0073).

McCormack fails to teach “a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language”. Tobita teaches a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language (fig.1; page 3, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormack to allow a gateway coupled between the application server and the telecommunications network for converting the html code of the web page to wireless markup language as taught by Tobita. The motivation for the modification is to have doing so in order to transmit the request to the contents server.

Regarding claim 18, McCormack teaches that the telecommunications network between the cell phone and the switch comprises a bearer wireless network and a public switched telephone network (fig.2; page 2, paragraph 0044, page 4, paragraphs 0070, 0072, 0073).

Regarding claim 19, McCormack fails to teach “the gateway is coupled to the cell phone via the bearer wireless network”. Tobita teaches that the gateway is coupled to the cell phone via the bearer wireless network (fig.1; page 3, paragraph 0032). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McCormack to allow the gateway coupled to the cell phone via the bearer wireless network as taught by Tobita. The motivation for the modification is to have doing so in order to convert an intrinsic identifier of a mobile phone added to the request and transmit the request to the contents server.

Regarding claim 20, McCormack teaches that the telecommunications network is packet switched permitting parallel downloads (fig.2; page 4, paragraphs 0070, 0072, 0073).



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Regarding claim 23 is rejected for the same reasons as discussed above with respect to claim 16.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gregorek et al. (U.S. Patent No. 5,557,658) teach Communications marketing system.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and for After Final communications.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [shafiulalam.elahee@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4750.

**Any response to this action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, DC 20231

**or faxed to:**

(703) 308-5397(for formal communications intended for entry; please mark "EXPEDITED  
PROCEDURE")

(703)**306-5406**(for informal or draft communications, such as proposed amendments to be  
discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

**or hand-carried to:**

Crystal Park Two

2121 Crystal Drive

Application/Control Number: 09/892,964

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Arlington, VA.

Sixth Floor (Receptionist)

*M.E.*

MD SHAFIUL ALAM ELAHEE

May 21, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to be 'Fan Tsang', written over the printed name and title.